

Docket No.: 259908US0XPCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

YOSHINORI NAOE, ET AL

: EXAMINER: CARTER, K. D.

SERIAL NO.: 10/508,958

:

FILED: DECEMBER 12, 2005

: GROUP ART UNIT: 1617

FOR: DEPSIPEPTIDE FOR THERAPY OF KIDNEY CANCER

RESPONSE TO RESTRICTION REQUIREMENT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313-1450

SIR:

Responsive to the Official Action dated February 22, 2007, Applicants elect, with traverse, Group I (Claims 1-7 and 12-15) for further prosecution.

REMARKS

The Office has required restriction in the present application as follows:

- | | |
|------------|---|
| Group I: | Claims 1-7 and 12-15, are drawn to a method of treating kidney cancer in mammals comprising administering an effective amount of a compound of formula I or II. |
| Group II: | Claims 8-11, are drawn to a therapeutic agent of kidney cancer comprising an active ingredient of the compound of formula I or II. |
| Group III: | Claims 16-20, are drawn to a pharmaceutical composition and commercial package for treating kidney cancer comprising a compound of the formula I or II. |

Applicants elect, with traverse, Group I (Claims 1-7 and 12-15) for further prosecution.

Applicants traverse the Restriction Requirement on the grounds that the Office has not applied the same standard of unity of invention as the International Preliminary Examination Authority (a copy of the International Preliminary Examination Report originally filed on December 12, 2005). The Authority did not take the position that unity of invention was lacking in the International application and examined all claims together. Applicants note that PCT Article 27(1) states:

No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.

Moreover, Applicants respectfully traverse on the grounds that the Office has not shown that a burden exists in searching the entire application.

MPEP in §803 states as follows:

If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. In fact, the International Searching Authority has searched all of the claims together.

Applicants submit that the present application is in condition for examination on the merits. Early notification to this effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Stephen G. Baxter, Ph.D.
Registration No. 32,884

Vincent K. Shier, Ph.D.
Registration No. 50,552

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 08/03)